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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,634	08/24/2001	Jeffrey Green	NAIIP092/01.050.01	1385
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EXAMINER				
CLOUD, JOIYA M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/935,634

Applicant(s)

GREEN ET AL.

Examiner

Joiya M. Cloud

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-15, 23-30, 32, 34, 36-39 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15, 23-30, 32, 34, 36-39 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to communications 10/20/2008. Claims 1-10, 12-15, 23-27, 28-30, 32, 34, 36-39 and 41-44 are PENDING. Applicant's arguments have been carefully considered but are moot in view of new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-10, 12-15, 23-27, 28-30, 32, 34, 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al., (U.S. Patent No. 6,901,519) in view of Alam et al. (US Patent No. 6,336,124 B1)

As per claim 1, Stewart discloses the invention substantially as claimed. Stewart teaches a method carried out by a computer when executing computer-readable program code, the method comprising: receiving a certain electronic file intended for delivery from a sender to an intended recipient, the certain electronic file having a first file format having a first file extension and containing a computer virus (Stewart, col.3, l.60-col.4, l.3); and prior to the certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format having a second file extension that is different from the

first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient (Stewart, col.3, 1.56-64); wherein it is determined whether the certain electronic file represents a potential risk to security of a computer system (Stewart, col.3, 1.45-55); and said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer systems (Stewart, col.3, 1.35-39).

However, Stewart does not explicitly disclose wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML, file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type.

Alam teaches wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML, file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type. **(col. 6, lines 9-32, wherein it is determined if the first file format (input file) is one of a word processing file**

type, Alam discloses a WORD file converted into a second file format HTML, where alternate input and output file formats are disclosed in col. 2, lines 28-36. Alam discloses wherein the first file format is a graphics file format type (image document, Figure 6, item 518 that is converted to an output format (GIF, BMP, col. 2 and col. 20, lines 8-29).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporate Stewart's teachings to the teachings of Alam's for the purpose of converting data "representing a document to a format suitable for display in a display having configuration different from those for which the input format is suitable." and reformatting for display (**col. 15, lines 42-45**).

As per claim 2, Stewart-Alam further discloses the method of claim 1, the certain electronic file being an attachment to an electronic mail sent over a network

(**Stewart, col. 3, l.28-30**).

As per claim 3, Stewart-Alam further discloses the method of claim 2, the network including the internet (**Stewart, col.3, l.30-31**).

As per claim 4, Stewart-Alam further discloses the method of claim 1, said receiving occurring at a desktop computer of the intended recipient (**Stewart, fig.1**).

As per claim 5, Stewart-Alam further discloses the method of claim 1, said receiving occurring at a server computer (**Stewart, col.3, l.28-30, fig.1**).

As per claim 6, Stewart-Alam further discloses the method of claim 1, said

receiving occurring at a gateway computer (**Stewart, col. 3, 1.12-14**) .

As per claim 8, Stewart-Alam further discloses the method of claim 1, said converting occurring at a server computer (**Stewart, col.4, 1.28-30**).

As per claim 9, Stewart-Alam further discloses the method of claim 1, said converting occurring at a gateway computer (**Stewart, fig. 1**).

As per claim 10, Stewart-Alam further discloses the method of claim 1, said converting occurring prior to the intended recipient receiving the certain electronic file (**Stewart, col. 3, 1.16-22**).

As per claim 12, Stewart-Alam further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: determining if the certain electronic file contains the computer virus (**Stewart, col. 3, 1.45-55**).

As per claim 13, Stewart-Alam further discloses the method of claim 1, said determining whether the certain electronic file represents the potential risk comprising: conducting a heuristic scan of the certain electronic file (**Stewart, col. 4, 1.1-10**).

As per claim 14, Stewart-Alam further discloses the method of claim, the certain electronic file being a first electronic file, further comprising: receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus (**Stewart, col.5, 1.14-18**), in which the additional file that are unexpected changed including name, content and extension); and prior to the second electronic file being made available for

viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient (**Stewart, col.5, 13-14, a special validation process is performed, see fig. 3).**

As per claims 15, Stewart-Alam further discloses the method of claim 1, the computer virus including a macro virus (**Stewart, col.4, 1.1-25).**

As per claim 18, Stewart-Alam further discloses the method of claim 16, the second file format being the ASCII file format file (**Stewart, col.3, 1.60-61, alphanumeric only text file).**

As per claim 19, Stewart further discloses the method of claim 16, the second file format being the TXT file format (**Stewart, col.3, 1.60-61, alphanumeric only text file).**

As per claim 20, Stewart-Alam further discloses the method of claim 1, the second file format being a file format having text without scripts (**Stewart , col.4, 1.38-40).**

As per claim 21, Stewart-Alam further discloses the method of claim 1, the certain electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphics file, a presentation file, a compressed file, and a binary executable file (**Stewart, col.4, 1.24-27).**

As per claims 24-26 have similar limitation as claims 1 and 12.

Therefore, claims 24-26 are rejected under Stewart for the same reason set forth in the rejection of claim 1 and 12.

As per claim 27, Stewart-Alam further discloses the method of 24, said determining comprising: determining whether content of the electronic file reflects a potential computer virus (**Stewart, col. 3, 1.35-44**).

As per claims 28-30, 32, and 35 have similar limitation as claims 1,2, 10-12, 15, and 21. Therefore, claims 28-30, 32, and 35 are rejected under Stewart for the same reason set forth in the rejection of claim 1,2,10-12, 15, and 21.

As per claims 34, Stewart-Alam further discloses the method of claim 28, the computer virus being a macro virus (**Stewart, col.4, 1.1-25**).

Claim Rejections - 35 USC § 103

Claims 7 and 36-39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart-Alam in view Schwabe et al (**US 2003/0028686 A1**).

Stewart-Alam discloses the invention substantially as claimed. However, Stewart-Alam does not explicitly disclose converting occurring at a desktop computer of the intended recipient.

Schwabe discloses converting occurring at a desktop computer of the intended recipient (**paragraph [0042], see also paragraph [0029] for further detail**).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporate Stewart-Alam's teachings to the teachings

of Schwabe for the purpose of providing a “suitable platform” for conversion of files
(paragraph [0042]).

As per claims 36-37 have similar limitation as claims 1, and 7.

Therefore, claims 36-37 are rejected under Stewart for the same reason set forth in the rejection of claim 1, and 7.

As per claim 38, Stewart-Alam-Schwabe further discloses the apparatus of claim 36, said computer being a server computer of a local area network (**Stewart, col.21, l.20**).

As per claim 39, Stewart-Alam-Schwabe further discloses the apparatus of claim 36, said computer being a gateway computer (**Stewart, fig 1**,
42)).

Response to Arguments

A). Therefore, the technique claimed by the applicant does not require that only one condition be met, as argued by Examiner.

As to the above point A), Examiner respectfully disagrees. The instant claims after Applicant’s amendments filed 10/28/2008 continue to recite two embodiments, (i.e. wherein “if the first file format is one of a word processing file format type and a graphics file format type.”). In other words, the claims are drawn towards wherein the first file format **is one of** a), a word processing file format type and b) a graphics file format type. Again, the claims only require determining that a first file format is either a word processing file format type or a graphics file format type. Thus, for example, if it is determined that the first file format is a word processing file format type, the remaining limitations regarding if it is

determined to be a graphics file format type is not required. This is substantially different from a positive recitation of the claim language, for instance, “wherein it is determined *when* the first file format is one of a word processing file format type and a graphics file format type...” Therefore, Examiner submits that only one embodiment is required to anticipate the claim language as amended by Applicant. Examiner suggests Applicant further amend the claim language to reflect the above discussed distinction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

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(toll-free).

JMC

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444

December 7, 2008